UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,220	07/22/2003	Ted Margison	067182-011	8360

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EXAMINER
MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/625,220	MARGISON, TED
	Examiner	Art Unit	
	Susanna M. Diaz	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 July 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-42</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-42</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-42 are presented for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-30 and 33-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Since the scope of the comparing step recited in claims 1-29, 41, and 42 is vague and indefinite (as discussed the § 112, 2nd paragraph rejection below), it is unclear whether or not these claims recite a useful, concrete, and tangible result. Furthermore, claims 1-29, 41, and 42 only incorporate a nominal recitation of technology (e.g., a user interface to display data and receive selections from members). Therefore, claims 1-29, 41, and 42 are deemed to be non-statutory.

Claim 30 merely recites storing data; therefore, it fails to produce a useful, concrete, and tangible result. Furthermore, claim 30 only incorporates a nominal recitation of technology (e.g., a user interface to display data and receive selections from members). Therefore, claim 30 is deemed to be non-statutory.

Claims 33-40 recite a data structure *per se*, which is non-statutory subject matter.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1-29, 31, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of "comparing the selections made by the members" in line 1 is vague and indefinite. Does this limitation merely refer to recording input from the members made in the form of selections or is detailed analysis performed to evaluate such a comparison? If detailed analysis is performed, who or what (e.g., a computer) carries

out the analysis and what is the extent of the analysis? Applicant should cite pertinent

excerpts from the specification to support the intended interpretation. A similar

limitation is recited in claims 31, 41, and 42; therefore, claims 31, 41, and 42 are

rejected under the same line of reasoning.

In claim 23, there is no antecedent basis for "the first areas" (line 2) and "the

second areas" (line 5). For examination purposes, "the first areas" will be interpreted as

"the first area" and "the second areas" will be interpreted as "the second area."

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Guenther et al. (US 2003/0139956) in view of Barney et al. (U.S. Patent No. 6,070,143).

Guenther discloses a process for profiling an organization having members

comprising:

[Claim 1]   presenting to members a survey, the results which are saved to a

database that contains a plurality of processes of the organization and, for each

process, a plurality of selectable characterizations of the process (Figs. 3, 5, 6; ¶¶ 72-

89, 100; Appendices A and B -- Workers are asked to evaluate various aspects of their

roles. Tables 1-5 display various answers that may be given by a worker regarding a process within the organization);

receiving selections from members through the survey of one or more of the characterizations of one or more of the processes (Figs. 3, 5, 6; ¶¶ 72-89, 100; Appendices A and B -- Workers are asked to evaluate various aspects of their roles. Tables 1-5 display various answers that may be given by a worker regarding a process within the organization. Multiple workers may be given the same survey questions (e.g., an audience segment may include a group of workers in a role category, as per ¶ 70));

storing the selections of the characterizations made by the members, including the selections of one or more characterizations of the same process by at least two members, along with an identification of the members that made the selections (¶¶ 72, 77-79 -- Data is stored and compared for different roles. Each member is at least identified by his/her respective role);

comparing the selections made by the members, including the selections of one or more characterizations of the same process by at least two members (¶¶ 77-79 -- Data is stored and compared for different roles); and

generating a presentation concerning the selections made by the members, including the selections of one or more characterizations of the same process by at least two members (¶¶ 77-79; 87-89 -- Reports, i.e., presentations, summarizing results of the role analysis are generated);

[Claim 2]   wherein the presentation includes an identification of an inconsistency in the characterizations of the same process by at least two members (¶¶ 79, 87-89, 109 -

- Changes in a role(s) over time or gaps in skill, knowledge, or tasks, related to a role(s)

may be identified by comparing stored role analysis profiles and recently gathered

ones);

[Claim 3]   receiving selections from members, including selections of one or more of

the same processes by at least two members (Figs. 3, 5, 6; ¶¶ 72-89, 100; Appendices

A and B -- Workers are asked to evaluate various aspects of their roles. Tables 1-5

display various answers that may be given by a worker regarding a process within the

organization. Multiple workers may be given the same survey questions (e.g., an

audience segment may include a group of workers in a role category, as per ¶ 70));

storing the selections of the processes entered by the members, including the

selections of one or more of the same processes by at least two members, along with

an identification of the members that made the selections (¶¶ 72, 77-79 -- Data is

stored and compared for different roles. Each member is at least identified by his/her

respective role);

[Claim 4]   wherein at least some of the processes are job functions in the

organization (¶¶ 81, 83, Tables 1, 3);

[Claim 6]   wherein at least some of the selectable characterizations of a job function

are systems that are used with the job function (¶¶ 82, 84, Tables 2, 4);

[Claim 7]   wherein at least some of the selectable characterizations of a job function

are organizations that are involved with the job function (Appendix B shows various

identified organizations involved with the job functions -- For example, "#4. Question 20"

mentions resolving problems with "internal and external stake holders and vendors."

"#5. Question 21" mentions working with "team on the design of test cases." "#6.

Question 26" mentions coordinating with "Third Party requirements" and conducting

negotiation with "stake holders." "#7. Question #31" mentions linking with "architects

and customers");

[Claim 8]   wherein at least some of the selectable characterizations of a job function

are products or services associated with the function (¶¶ 81-85, Tables 1-5);

[Claim 10]   wherein at least some of the selectable characterizations of a job function

are one or more processes that precede the job function (¶ 82, Table 2 -- Prerequisites

for a role);

[Claim 11]   wherein at least some of the selectable characterizations of a job function

are inputs to or outputs from the job function (¶¶ 81-85, Tables 1-5 -- Any skills or

training (i.e., prerequisites) required to perform a role are inputs to a job function and

the tasks associated with the role define the goal, or intended output, of each related job

function. For example, by developing middleware architectures for customers (as per

Table 1), it is understood that the developed middleware architectures are the delivered

outputs);

[Claim 12]   wherein at least some of the selectable characterizations of a job function

include an identification of what is delivered in connection with an input to or output from

the job function (¶¶ 81-85, Tables 1-5 -- Any skills or training (i.e., prerequisites)

required to perform a role are inputs to a job function and the tasks associated with the

role define the goal, or intended output, of each related job function. For example, by

developing middleware architectures for customers (as per Table 1), it is understood

that the developed middleware architectures are the delivered outputs);

[Claim 13]   wherein what at least some of the selectable characterizations of a job

function include a description of how an item is delivered in connection with an input to

or an output from the job function (¶¶ 81-85, Tables 1-5 -- Any skills or training (i.e.,

prerequisites) required to perform a role are inputs to a job function and the tasks

associated with the role define the goal, or intended output, of each related job function.

For example, by developing middleware architectures for customers (as per Table 1), it

is understood that the developed middleware architectures are the delivered outputs);

[Claim 14]   wherein at least some of the selectable characterizations of a job function

include an identification of what action the member takes in connection with an input to

or an output from the job function (¶¶ 81-85, Tables 1-5 -- Any skills or training (i.e.,

prerequisites) required to perform a role are inputs to a job function and the tasks

associated with the role define the goal, or intended output, of each related job function.

For example, by developing middleware architectures for customers (as per Table 1), it

is understood that the developed middleware architectures are the delivered outputs);

[Claim 15]   wherein at least some of the selectable characterizations of a job function

include the importance of an input to or an output from the job function (¶¶ 81-85,

Tables 1-5 -- Any skills or training (i.e., prerequisites) required to perform a role are

inputs to a job function and the tasks associated with the role define the goal, or

intended output, of each related job function. For example, by developing middleware

architectures for customers (as per Table 1), it is understood that the developed

middleware architectures are the delivered outputs. A worker's selection of one or more

input(s) or output(s) as opposed to others implies the respective importance of the

selected input(s) and/or output(s));

[Claim 16]   wherein at least some of the selectable characterizations of a job function

include an identification of what action the member takes in connection with an input to

or an output from the job function (¶¶ 81-85, Tables 1-5 -- Any skills or training (i.e.,

prerequisites) required to perform a role are inputs to a job function and the tasks

associated with the role define the goal, or intended output, of each related job function.

For example, by developing middleware architectures for customers (as per Table 1), it

is understood that the developed middleware architectures are the delivered outputs);

[Claim 18]   wherein at least some of the selectable characterizations of a job function

include a trigger for an input to or output from the job function (¶¶ 81-85, Tables 1-5 --

Any skills or training (i.e., prerequisites) required to perform a role are inputs to a job

function and the tasks associated with the role define the goal, or intended output, of

each related job function. For example, by developing middleware architectures for

customers (as per Table 1), it is understood that the developed middleware

architectures are the delivered outputs; Appendix B shows various implied workflows,

i.e., tasks and training needed to begin or complete a given job).

Regarding claims 1-29, Guenther's workers responds to a consultant's open-

ended survey questions regarding a job analysis via an interview or focus group (¶¶ 73,

103). Guenther does not expressly teach that the workers complete such a survey via

an electronic user interface nor that the survey interface itself provides a list of

selectable answers from which each of multiple workers chooses a response to each

question. However, Barney discloses a job analysis system/method that "allows a job

analyst quickly to identify, review and manipulate pre-existing products construed from

past job analyses" and "allows accessibility across wide geographical spans and

multiple types of computer platforms" and "ensure[s] ongoing data integrity" (col. 2, lines

41-50). Barney provides each user with an interface specifically relevant to each job

title (Fig. 6). Various characterizations of job-related functions are displayed in drop-

down lists of available selections, including those associated with required skills,

training, tasks, work behaviors, etc. (Figs. 6, 8A-11B). Both Guenther and Barney focus

on the analysis of various jobs (or roles) and related requirements and Barney presents

an automated job analysis tool that is pertinent to Guenther's goal of gathering job/role

analysis information from multiple workers familiar with common jobs and roles.

Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill

in the art at the time of Applicant's invention to modify Guenther to incorporate Barney's

job analysis user interface with selectable job analysis factors (including those

specifically recited in claims 6-18) accessible via drop-down menus to allow Guenther's

consultant (or job analyst) to more quickly identify, review, and manipulate pre-existing

job analysis data while conducting surveys more conveniently with workers who may be

geographically dispersed (as suggested by Barney). Furthermore, the Examiner

submits that it is old and well-known in the art of surveying to require a group of survey

participants to select from among a list of pre-defined responses in order to facilitate the

more consistent use of terminology among the participants (as opposed to letting the participants express responses in their own words), thereby simplifying the interpretation of the participants' responses and analysis thereof. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to further modify the Guenther-Barney combination such that at least two members are provided with the same survey selections (i.e., the multiple survey respondents are given the same survey with the same available answers from which to select for each role) in order to facilitate the more consistent use of terminology among the participants (as opposed to letting the participants express responses in their own words), thereby simplifying the interpretation of the participants' responses and analysis thereof.

Claims 19-29 recite the details of the user interface presenting the survey to each member. As discussed above, Barney provides each user with an interface specifically relevant to each job title (Fig. 6). Various characterizations of job-related functions are displayed in drop-down lists of available selections, including those associated with required skills, training, tasks, work behaviors, etc. (Figs. 6, 8A-11B). In other words, Barney teaches the following features:

[Claim 19]   wherein the member is prompted to make a selection (Figs. 6, 8A-11B);

[Claim 20]   wherein the prompt includes a question (Figs. 6, 8A-11B);

[Claim 21]   wherein the user interface includes a first area for the member to make a selection in response to the prompt (Figs. 6, 8A-11B);

[Claim 22]   wherein the first area includes a drop-down box (Figs. 6, 8A-11B);

[Claim 23]   wherein the first area only allows the member to make a single selection

(Fig. 8A -- The user can deal directly with one outdent at a time);

the user interface includes a second area for the member to make selections

(Fig. 8B -- The user can drill down into an indent that allows the user to make multiple

selections); and

wherein the second area allows the member to make multiple selections (Fig. 8B

-- The user can drill down into an indent that allows the user to make multiple

selections);

[Claim 24]   wherein the user interface presents a series of prompts and includes an

overview area that visually illustrates the location of the current prompt in the series of

prompts (Figs. 8A-10 -- The highlighted box at the bottom of each screen indicates the

location of the current prompt in the series of prompts. The user can either move

through the indicated prompts in order or "Save and Exit" and move to a different

section. The user can also move to different areas by clicking on the respective

outdent/indent shown in Fig. 8A);

[Claim 25]   wherein the member alters the sequence of prompts by selecting an item

in the overview area other than the current prompt (Figs. 8A-10 -- The highlighted box at

the bottom of each screen indicates the location of the current prompt in the series of

prompts. The user can either move through the indicated prompts in order or "Save and

Exit" and move to a different section. The user can also move to different areas by

clicking on the respective outdent/indent shown in Fig. 8A);

[Claim 26]   wherein the user interface is presented to different members on different

computers (col. 3, lines 27-35);

[Claim 27]   wherein at least some of the characterizations are arranged in a

hierarchical format from general to specific and where members select characterizations

by navigating through the hierarchical format from general to specific (Figs. 8A-10);

[Claim 28]   wherein only a single characterization may be selected for a single

process (Fig. 8A -- The user can deal directly with one outdent at a time);

[Claim 29]   wherein a plurality of characterizations may be selected for a single

process (Fig. 8B -- The user can drill down into an indent that allows the user to make

multiple selections).

Again, both Guenther and Barney focus on the analysis of various jobs (or roles)

and related requirements and Barney presents an automated job analysis tool that is

pertinent to Guenther's goal of gathering job/role analysis information from multiple

workers familiar with common jobs and roles. Therefore, the Examiner asserts that it

would have been obvious to one of ordinary skill in the art at the time of Applicant's

invention to modify Guenther to incorporate the specific user interface details and global

access capabilities taught by Barney (and specifically pointed out in reference to claims

19-29 above) in order to allow Guenther's consultant (or job analyst) to more quickly

identify, review, and manipulate pre-existing job analysis data while conducting surveys

more conveniently with workers who may be geographically dispersed (as suggested by

Barney).

Regarding claims 5, 9, and 17, neither Guenther nor Barney expressly teaches that each member (i.e., worker or survey participant) enters a date when he/she began or ended a job function and storing the date received, a time frame for performing a job function and storing the time frame, or a time frame for receiving the input to or output from the job function. However, Guenther and Barney compare pre-existing job definitions to more recent, updated job analyses in order to glean the most accurate and current understanding of the functions associated with the job/role of interest (see ¶¶ 71, 77, and 86-89 of Guenther and col. 2, lines 41-44 and col. 6, lines 5-8 of Barney). Further, the Examiner submits that it is old and well-known in the art of job analysis that the requirements, functions, input, and outputs of different jobs/roles often evolve over time. This means that the value of the survey responses provided by each member is date-dependent. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with the Guenther-Barney combination the steps of receiving from a member a date when the member began or ended a job function and storing the date received (claim 5); receiving from a member a time frame for performing a job function and storing the received time frame (claim 9); wherein at least some of the selectable characterizations of a job function include an identification of a time frame for receiving the input to or output from the job function (claim 17) in order to assist a job analyst in gleaning the value of each member's survey responses based on an understanding of the time period corresponding to each respective member's most recent experience(s) with a particular job/role. For example, the feedback from a member who has extensively

worked in the IT industry within the past year is likely to be more accurate and up-to-date, and therefore more valuable, than feedback from a member whose opinions are based on experience in the IT industry that ended over ten years ago.

[Claim 30]   Claim 30 recites limitations already addressed by the rejection of claim 1 above; therefore, the same rejection applies.

[Claim 31]   Claim 31 recites limitations already addressed by the rejection of claim 1 above; therefore, the same rejection applies.

[Claim 32]   Claim 32 recites limitations already addressed by the rejection of claim 1 above; therefore, the same rejection applies.

[Claims 33-36]   Claims 33-36 recite limitations already addressed by the rejection of claims 1, 4, 11, and 12 above; therefore, the same rejection applies.

[Claims 37-40]   Claims 37-40 recite limitations already addressed by the rejection of claims 1, 4, 11, 12, and 33-36 above; therefore, the same rejection applies.

[Claims 41-42]   Claims 41-42 recite limitations already addressed by the rejection of claims 1 and 2 above; therefore, the same rejection applies.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morrel-Samuels (US 2003/0078804) -- Discloses an employee assessment tool.

Brown et al. (US 2005/0010469) -- Discloses a consulting assessment

environment that facilitates the encoding of electronic questionnaires to perform

consulting interviews/surveys previously performed by hand.

Griffor et al. (US 2002/0173999) -- Discloses a performance management

system that assesses the achievement of organizational goals.

Miller et al. (US 2003/0110067) -- Discloses a system/method for evaluating an

organization's Capability Maturity Model.

Das ("Training for Changing Material Role Behaviour") -- Discusses issues

associated with role conflict, role ambiguity, and responsibility boundaries.

Michalak ("The Cost of Chasing Unrealistic Project Schedules") -- Discusses

roles and responsibilities as they related to project responsibility, accountability, consult,

inform (RACI) diagrams.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-

6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Susanna Diaz
Susanna M. Diaz
Primary Examiner
Art Unit 3623

May 22, 2005